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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,171	11/09/1999	ANDREAS BLECKMANN	BEIERSDORF59	6227

7590

07/10/2003

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/10/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/436,171

Applicant(s)

BLECKMANN ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Claims 1, 3-5, 7-9 and 11 are pending. The Amendment filed 3/14/03, Paper No. 22, amended claim 1 and cancelled claim 2.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/25/03 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-5, 7-9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "condensation products of polyglycols and amines" in claim 1 (part (c)) is vague and indefinite, as the metes and bounds of this claim are unascertainable. Are the condensation products the result of a reaction between polyglycols and amines? Are the condensation products the result of a reaction between polyglycols and other compounds? Are the condensation products the result of a reaction between amines and other compounds? The specification does not define this phrase and one of ordinary skill in the art would not be apprised of its meaning.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5, 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. (WO 98/17232) in view of Dupuis et al. (6,338,858).

The instant invention is directed to a water-in-oil emulsion with a content of water and optionally water-soluble substances totaling greater than 85% by weight, and with a content of lipids, emulsifiers and lipophilic constituents of less than 15% by weight, comprising a surface-active substance of formula (I), and a cationic polymer.

Schreiber et al. teach water-in-oil emulsions comprising 30-85% of an aqueous phase, and preferably 1-20% of a lipid phase, and a surface active substance of formula (I) of the instant invention. PEG-30 dipolyhydroxystearate is disclosed a surface-active substance. Oils disclosed include branched and unbranched hydrocarbons. The reference lacks cationic polymers. See pg. 4-15; pg. 17; pg. 19-40.

Dupuis et al. teach aqueous solid topical compositions. Water-in-oil emulsions are disclosed as cosmetic forms. Cationic polymers, comprising 0.001-5% of the compositions, are disclosed as conditioning agents for use in the compositions. Specifically disclosed as a cationic polymer is JR 400, wherein JR 400 is polyquaternium-10. See Col. 1, lines 1-30; Col. 5, lines 51-57; Col. 7, lines 59-Col. 8, line 20.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the cationic polymers of Dupuis et al. to the compositions of Schreiber et al. because a) Schreiber et al. and Dupuis et al. are both directed to cosmetic water-in-oil stick emulsions, wherein lipsticks are specifically exemplified; b) Dupuis et al. teach that adding cationic polymers to such emulsions results in a conditioning effect; hence, one of ordinary skill in the cosmetic art would be motivated to add the cationic polymer taught by Dupuis et al. into the composition of Schreiber et al. because of the expectation of achieving a composition that imparts conditioning benefits to the skin, especially to the lips.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. in view of Dupuis et al. as applied to claims 1, 3, 5, 7-9 and 11 above, and further in view of Yoneyama et al. (5,015,469).

Schreiber et al. and Dupuis et al. are applied as discussed above. The references lack preferred oils.

Yoneyama et al. teach water-in-oil emulsion type cosmetics comprising cationic surfactants. Hydrocarbon oils such as liquid paraffin, isopropyl myristate, waxes such as petrolatum, and silicone oils are disclosed as comprising the oil components. See abstract; Col. 5, line 5-Col. 6, line 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the liquid paraffin of Yoneyama et al. for the oils taught by the combined references because a) the combined references and Yoneyama et al. are both directed to water-in-oil cosmetic emulsions; b) the combined references teach isopropyl myristate and silicone oils for use in their oil phase and Yoneyama et al. teach liquid paraffin as interchangeable with

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isopropyl myristate and silicone oils in the oil phase of cosmetic water-in-oil emulsions; thus, one of skill in the art would be motivated to teach liquid paraffin in the composition of the combined references because of the expectation of achieving similar cosmetic oil effects and because the combined references teach that their oil phase can comprise branched and unbranched hydrocarbons.

Response to Arguments

Applicant argues, "although the compositions would generically be referred to as cosmetic compositions, there is no predictability or suggestion that one would 'pick and choose' selected elements out of Dupuis et al. and Yoneyama et al. and substitute them into Schreiber et al.". This argument is not persuasive. See the above rejection, which clearly states the motivation to combine the references.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

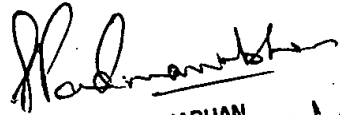
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
June 4, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER 6/8/03